



#12
m.m.
7/30/03
Docket No. 3123-4006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): EMALFARB, et al.

EV245482586US

Serial No.: 09/834,434

Group Art 1639

Filed: April 13, 2001

Examiner: Teresa D. WESSENDORF

For: HIGH THROUGHPUT SCREENING OF EXPRESSED DNA LIBRARIES IN
FILAMENTOUS FUNGI

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated May 21, 2003. A petition and fee for a one-month extension of time, extending the time for filing a response up to, and including, July 21, 2003, is enclosed herewith.

With respect to the requirement for an election of an invention, Applicants hereby provisionally elect Group II, claims 3-5 and 10-12, with traverse. Applicants further provisionally elect the species of subgroup E.

Applicants respectfully traverse the restriction of groups I through IX. The Examiner contends that the application contains nine patently distinct inventions, and that restriction is therefore proper. However, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. See MPEP 803. Applicants respectfully submit that all claims of groups I-IX can be examined without undue burden.

In particular, Applicants respectfully traverse the restrictions of groups I, II, VII and VIII. The Examiner contends that each of the inventions are unrelated because each are "drawn to different methods with different modes of operation having different steps with different functions and/or effects or results". Applicants respectfully point out that claim 3 contains all of the limitations of claim 1, with the additional limitations of screening and isolating a DNA molecule of interest. Therefore, a search that finds claim 1 allowable would also very likely be sufficient to find

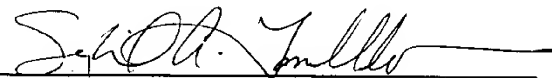
claim 3 allowable. In addition, claims 46 and 47 contain the same limitations found in claim 1 with respect to the steps involved for making a library of transformed filamentous fungi. Therefore, a search that finds claims 46 and 47 allowable would also very likely be sufficient to find claim 1 allowable. For these reasons, Applicants respectfully submit there is no undue burden associated with searching on the subject matter of the claims contained in groups I, II, VII and VIII.

In view of the remarks above, Applicants respectfully request that groups I, VII and VIII be rejoined with group II. Should the Examiner make the restriction final, Applicants reserve the right to prosecute the non-elected claims in continuing or divisional applications, and reserve the right to traverse the restriction requirements applied to the non-elected claims.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: July 21, 2003

By:



Sybil A. Lombillo,
Registration No. P54,280

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154-0053
(212) 758-4800 Telephone
(212) 751-6849 Facsimile



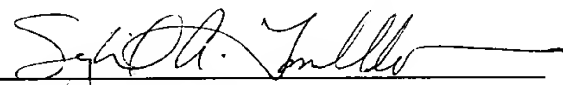
claim 3 allowable. In addition, claims 46 and 47 contain the same limitations found in claim 1 with respect to the steps involved for making a library of transformed filamentous fungi. Therefore, a search that finds claims 46 and 47 allowable would also very likely be sufficient to find claim 1 allowable. For these reasons, Applicants respectfully submit there is no undue burden associated with searching on the subject matter of the claims contained in groups I, II, VII and VIII.

In view of the remarks above, Applicants respectfully request that groups I, VII and VIII be rejoined with group II. Should the Examiner make the restriction final, Applicants reserve the right to prosecute the non-elected claims in continuing or divisional applications, and reserve the right to traverse the restriction requirements applied to the non-elected claims.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: July 21, 2003

By: _____


Sybil A. Lombillo,
Registration No. P54,280

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154-0053
(212) 758-4800 Telephone
(212) 751-6849 Facsimile